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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/823,260 | 04/13/2004 | Jeffrey M. Cosman | 228559 | 3492 |
| 23460 | 7590 | 11/12/2004 | | |
| LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780 | | | EXAMINER SOOHOO, TONY GLEN | |
| | | | ART UNIT 1723 | PAPER NUMBER |

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,260

Applicant(s)

COSMAN ET AL.

PH

Examiner

Tony G. Soohoo

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 sheets. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. This is a continuation of applicant's earlier application 09/884,551.

Pending claims are 1-20.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Note with regards to the final intended use of the liquid concentrate prepared by the process in manufacture of plastic parts, whereby the body of the claims do not limit the use of the concentrate in any other operation by positively reciting a step of introducing the concentrate into a plastic material, the final intended use of the composition produced by the process is denied patentable consideration and limitation to the process claims.

3. Claims 1, 6, 12-13, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hotchkiss, III 5469068 (Hotchkiss).

With regards to the method claims, the Hotchkiss reference teaches

A) preparing liquid intermediates to be placed in tint meter stations 32a, 32b, 32c at a factory which known in the art of paint composition and mixing includes tint pigments, carrier liquid such as solvent and stabilizer components (refer to application claims 6,13), and B) producing the tints so that each tint is of known and standardized characteristics, C) transferring the standardized liquid intermediates to a remote location for feed into the tint meter stations 32a, 32b, 32c at the dispensing point of the store, and D) dispensing the liquid intermediates to produce a liquid concentrate blend of a

particular color formula into a bag 22 for later addition to a base paint whereby the concentrate is mixed to the final paint composition.

With regards to claim 12 note that a formula of step D) may be considered as the color choice by the consumer from a paint chip sample brochure/ swag catalog whereby the formulae is based so that it may match the chosen paint chip sample or to a swag of material to match chosen fabrics in a room design.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5, 7, 14-17, and 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotchkiss, III 5469068 in view of Haaser et al 5938080.

Hotchkiss, III 5469068 discloses all of the recited subject matter as defined within the scope of the claims with the exception of

1) the method step and apparatus to provide a gravimetric formula and thus gravimetric dispensing of the intermediate liquid from the tint meter stations 32a, 32b, 32c, and 2) the method and apparatus use of a computer control of the dispensing and provision of the formula into the computer to control the dispensing.

The patent to Haaser teaches that pigments may be dispensed using a weigh scale 68 control step and means thus providing a gravimetric dispensing of the tint in response to a PC computer control with the desired formula in the PC programmed by keyboard or remotely, column 4, lines 56-58. Additionally, it is old and well known in the art that a PC may be programmed (formula) locally (keyboard) or programmed at a remote location using (floppy disk data transfer, internet, LAN connections).

In view of the teaching of Haaser that one may use a PC and weigh scale for a gravimetric control and dispensing of colorant for a mixture for a more precise control blend of the final product via the use of a more efficient PC control via a local console 78 or remote location programming of the dispensing of the material from a formula, it is deemed that it would have been obvious to one of ordinary skill in the art to modify the dispense control of the Hotchkiss tint meter stations 32a, 32b, 32c to use a weigh scale with programmable PC control for a more convenient and precise control of the tint blend so as to obtain a more precise and consistent color match of the concentrate in the bag 22.

With regards to the apparatus claim 20, It is noted that with regards to part a) the plural containers are shown. Issues to where the plural container has been filled does not structurally limit nor provide a structure distinction to the plural containers or the liquid within the container themselves since the claims are not method claims to the manipulation of the containers and liquid components.

6. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotchkiss, III 5469068 in view of Haaser et al 5938080 as applied to claims 7 and 19, respectively above, and further in view of Corbin et al 2848019.

Hotchkiss, III 5469068 in view of Haaser et al 5938080 discloses all of the recited subject matter as defined within the scope of the claims with the exception of the step of mixing the liquid intermediates prior to the dispensing of the components to the concentrate mixture.

The patent to Corbin teaches that a plural supply of different colorant 24, 24, 24, each may have an agitator 100, 102, 101 which may be operated continuously to prevent settling of the pigments thus the solids are recirculated within each reservoirs 24.

In view of Corbin that it is advantageous to provide a means and step of having have an agitator 100, 102, 101 which may be operated continuously to prevent settling of the pigments thus the solids are recirculated within each tint supply reservoirs 24 it is deemed that it would have been obvious to one of ordinary skill in the art to provide method and device of Hotchkiss's the tint metering device a step of continuously mixing the supply of the tint prior to dispensing into the concentrate bag containers, so that the tint is more uniform so that a more precise and consistent color blend is obtained.

Allowable Subject Matter

7. Claim 11 would be objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

the base claim and any intervening claims. However is also subject to a Double Patenting rejection made below in conflict with the parent application which matured into a Patent.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claim 11 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,719,453. This is a double patenting rejection.

Conclusion

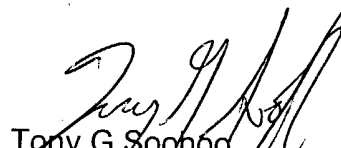
10. The prior art made of record in the parent application is noted as being not relied upon and considered pertinent to applicant's disclosure. The following disclose liquid colorant of plastic materials: Maguire 6007236, Shimoda 5225210, Campo et al 5723517, and 5559173, Tsukahara et al 5116547, Jakob 3814388.

11. Rushing et al 5823670 teaches the provision of a concentrate material produced to be brought to a work site 10 whereby another concentrate blend is made on site.

Art Unit: 1723

12. The following disclose methods of obtaining a colorant tint: Para 4225248, Rjossetti 4705083, Miller 4813785, Logan et al 2923438, Falcoff et al 4403866, Retamal et al 6494608, Harrison et al, Boers 6053218, Yon et al 6507824, Graf et al 6349300.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G. Soohoo whose telephone number is (571) 272 1147. The examiner can normally be reached on 7:00 AM - 5:00 PM, Tues. - Fri.. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.



Tony G Soohoo
Primary Examiner
Art Unit 1723

tgs